UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,545	09/29/2000	Neil Katz	6169-140	2722

40987 7590 05/12/2005		EXAMINER
AKERMAN SENTERFITT		BUI, KIEU OANH T
P. O. BOX 3188		

ART UNIT	PAPER NUMBER
2611	

WEST PALM BEACH, FL 33402-3188

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/676,545	KATZ ET AL.
	Examiner	Art Unit	
	KIEU-OANH T. BUI	2611	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 April 2005</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9 and 17-20* is/are pending in the application.

   4a) Of the above claim(s) *19 and 20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9, 17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
   application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)   4)☐ Interview Summary (PTO-413)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   Paper No(s)/Mail Date. _____.
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)   5)☐ Notice of Informal Patent Application (PTO-152)
    Paper No(s)/Mail Date _____.   6)☐ Other: _____.

DETAILED ACTION

Remarks

1.   Claims 10-16 and 19-20 were withdrawn, and claims 21-27 were canceled in the

amendment paper no. 7 (dated 05/07/04). Pending claims are now claims 1-9 and 17-18.

Response to Arguments & Priority

2.   Applicant's arguments with respect to claims 1-9 and 17-18 have been considered but are

moot in view of the new ground(s) of rejection. The Examiner acknowledges the priority date is

now at October 6, 1999 as claimed in the remarks/argument dated 09/20/04.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

*(e) the invention was described in (1) an application for patent, published under section
122(b), by another filed in the United States before the invention by the applicant for
patent or (2) a patent granted on an application for patent by another filed in the United
States before the invention by the applicant for patent, except that an international
application filed under the treaty defined in section 351(a) shall have the effects for
purposes of this subsection of an application filed in the United States only if the
international application designated the United States and was published under Article
21(2) of such treaty in the English language.*

4.   Claims 1 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Wistendahl

et al. (US Patent No. 6,496,981 B1).

Regarding claim 1, Wistendahl discloses "a method for providing configurable access to

media in a media-on-demand system comprising the steps of: delivering the media to a first

client device through a first communications link wherein said first client device is associated

with a first user; recording a bookmark specifying a position in the media; and delivering the

media to a second client device through a second communications link, said delivery to said

second client device beginning at said position specified by said recorded bookmark <u>wherein</u>

<u>said second client device also is associated with said first user</u>", i.e., as illustrated in Figure 4 and

Figs. 7A & 7B, a first user of the interactive system associated with a first client device 32 (a set

top box) can access to video-on-demand system or server (Fig. 3) by using an user input or

pointer at 36 and/or 42, wherein the viewing device is a television, and the user can pause a

viewing program by using bookmarking feature, for instance, hotspots detection and storing (Fig.

4 & col. 5/lines 25-50 & col. 15/lines 25-38), and the second client device (a personal video

recorder, or VCR-like devices, col. 16/line 42 to col. 17/line 42) via a second communication

link later helps the user to resume at the point where the user hasn't finished viewing the

program or the first content, wherein the second client device is associated with the same first

user (see col. 11/line 65 to col. 12/line 50 as key frames are used for identifying a specific

location of stream if the user prefer to start at any particular location, and col. 16/line 42 to col.

17/line 42 for pausing or VCR-like functions in video on demand systems).

Regarding claim 17, Wistendahl discloses "a method for providing configurable access to

media in a media-on-demand system comprising: delivering the media to a first client device in a

format compatible with said first client device, <u>wherein said first client device is associated with</u>

<u>a first user</u>; interrupting said delivery of said media; recording a bookmark specifying a position

in the media when said interruption occurred; and resuming delivery of the media to a second

client device, said resumed delivery beginning at a position in the media specified by said

recorded bookmark, <u>wherein said second client device also is associated with said first user</u>";

i.e., as illustrated in Figure 4 and Figs. 7A & 7B, a first user of the interactive system associated

with a first client device 32 (a set top box) can access to video-on-demand system or server (Fig.

3) by using an user input or pointer at 36 and/or 42, wherein the viewing device is a television,

and the user can pause a viewing program by using bookmarking feature, for instance, hotspots

detection and storing (Fig. 4 & col. 5/lines 25-50 & col. 15/lines 25-38), and the second client

device (a personal video recorder, or VCR-like devices, col. 16/line 42 to col. 17/line 42) via a

second communication link later helps the user to resume at the point where the user hasn't

finished viewing the program or the first content, wherein the second client device is associated

with the same first user (see col. 11/line 65 to col. 12/line 50 as key frames are used for

identifying a specific location of stream if the user prefer to start at any particular location, and

col. 16/line 42 to col. 17/line 42 for pausing or VCR-like functions in video on demand systems).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.*

6.   Claims 2-9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Wistendahl et al. (US Patent 6,496, 981 B1 in view of Hooper et al. (U.S. Patent No. 5,442,390).

As for claims 2 and 18, in view of claim 1 above, Wistendahl does not further mention

the steps of identifying the devices; however, in a same environment of providing on-demand

services to users, Hooper discloses "further comprising the steps of identifying device properties

for each of said first and second client devices; and, delivering the media to said first and second

client devices through said respectively established first and second communications links, the

media delivered in a format compatible with said identified device properties", i.e., a

configuration process including customer's information and the configuration of their device is

performed for identifying a particular viewer and their associated device at their location on how

to communicate to them (Hooper, Fig. 4/step 420, and col. 8/lines 4-22). Therefore, it would

have been obvious to one of ordinary skill in the art at the time the invention was made to

modify Wistendahl's technique with well-known identifying technique as taught by Hooper in

order to ensure the service to deliver to subscribed customers to avoid fraudulent activities.

As for claim 3, in further view of claim 2 above, both Wistendahl and Hooper further

discloses "wherein the media is stored in a media-on-demand server (MODS) and delivered to

said first and said second client devices via said first and said second communications link

respectively", i.e., a media on-demand server for delivering video-on-demand (Wistendahl, Fig.

3, col. 7/lines 28-52 for video on demand addressed), and media is stored on media-on-demand

server or VOS system 20 and delivered to the CPE 10 at different locations via corresponding

links (Hooper, Fig. 1 with arrows for links, i.e.,, twisted pair of wires, coaxial cables, fiber optic

cables, micro-wave or satellite links, col. 3/lines 1-25).

As for claim 4, in further view of claim 3 above, Hooper further discloses "wherein said

step of delivering the media to said first client device via said first communications link,

comprises receiving the media from said MODS in an intermediate server; in said intermediate

server, converting the media to a format compatible with said identified device properties of said

first client device; and delivering said converted media to said first client device via said first

communications link", i.e., the media is delivered via a first communications link to a first client

device via an intermediate server as an interface box converter 11, this server converts the

receiving media to a compatible format to the client device, for instance, HDTV to a television

(Fig. 12, and col. 14/lines 4-54).

As for claim 5, in further view of claim 3 above, Hooper discloses "wherein said step of

delivering the media to a second client device via said second communications link, comprises:

receiving the media in an intermediate server from said MODS; in said intermediate server,

converting the media to a format compatible with said identified device properties of said second

client device; and delivering said converted media to said second client device via said second

communications link", i.e., the media is delivered via a second communications link to a second

client device via an intermediate server as an interface box converter 11, this server converts the

receiving media to a compatible format to the client device, for instance, signals to a monitor of a

personal computer PC (Fig. 12, and col. 14/lines 4-54).

As for claim 6, in further view of claim 3 above, Hooper discloses further "comprising:

storing the media in selected ones of a plurality of media-on-demand servers, each MODS in said

plurality of media-on-demand servers storing the media in at least one format compatible with a

selected device type; selecting a MODS for delivering the media to said first client device, said

selected MODS having stored thereon the media in a format compatible with said first client

device; and delivering from said selected MODS the media in a format compatible with said first

client device", i.e., a library server 23 with a juke box 41 serves as a stored media for clients in

selecting programs and each server stores media with compatible formats to the client device

with different ports to different networks (Fig. 2, and col. 4/lines 18-53).

As for claim 7, in further view of claim 6 above, Hooper further discloses "wherein said selecting step further comprises: determining if a MODS is available for delivering the media to said first client device in a format compatible with said first client device; if it is determined that a MODS is not available for delivering the media to said first client device in a format compatible with said first client device, selecting a MODS for delivering the media to said first client device, said selected MODS containing the media in a standard format, and converting the media in said standard format to a format compatible with said first client device", i.e., a configuration process is performed for providing appropriate type of broadcasting program if available, if not, an alternative choice such as creating a broadcast stream (col. 7/lines 25-37), as a standard format, to the client device (col. 8/lines 13-53), and then the broadcast stream is being converted at the interface converter as in claim 5 above.

As for claims 8 and 9, in further view of claim 3 above, Hooper further discloses "further comprising: storing the media in selected ones of a plurality of media-on-demand servers, each MODS in said plurality of media-on-demand servers storing the media in at least one format compatible with a selected device type; selecting a MODS for delivering the media to said second client device, said selected MODS having stored thereon the media in a format compatible with said second client device; and delivering from said selected MODS the media in a format compatible with said second client device" and "wherein said selecting step further comprises: determining if a MODS is available for delivering the media to said second client device in a format compatible with said second client device; if it is determined that a MODS is not available for delivering the media to said second client device in a format compatible with said second client device, selecting a MODS for delivering the media to said second client

device, said selected MODS containing the media in a standard format, and converting the media

in said standard format to a format compatible with said second client device", i.e., a

configuration process is performed for providing appropriate type of broadcasting program if

available, if not, an alternative choice such as creating a broadcast stream (col. 7/lines 25-37), as

a standard format, to the client device (col. 8/lines 13-53), and then the broadcast stream is being

converted at the interface converter as in claims 4-5 above, whether a second device is a HDTV

television or a PC.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Dan et al (US Patent 5,453,779) discloses system for scheduling policies with grouping fro

providing VCR control functions in a vide server.

8.   **Any response to this action should be mailed to:**

      Commissioner of Patents and Trademarks
      Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

9.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner

can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays

off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Christopher Grant, can be reached on (571) 272-7294.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KB
May 03, 2005

Krista Bui
Primary Examiner
Art Unit 2611